



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

SAVERIO CARL FALCO ET AL.

CASE NO.: BB1205 US NA

APPLICATION NO.: 09/464,528

GROUP ART UNIT: 1646

FILED: DECEMBER 15, 1999

EXAMINER: C. COLLINS

FOR: S-ADEOSYL-L-METHIONINE SYNTHETASE
PROMOTER AND ITS USE IN EXPRESSION
OF TRANSGENIC GENES IN PLANTS

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RESPONSE AFTER FINAL

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is submitted in response to the Office Action dated July 5, 2001 finally rejecting claims 1-11 of the above-identified application. Applicants respectfully request entry of this Response After Final because it is believed to place the claims in form for allowance or, in the alternative, to place the claims in better form for consideration on appeal. Reconsideration is respectfully requested and the following is submitted in support thereof.

In the Claims

7. (twice amended) Seed of the plant as in any one of claims 3-6 wherein said seed comprises in its genome the chimeric gene of claim 2.

Remarks

Claims 1-7 stand rejected under 35 USC §112, first paragraph, on the ground that "given the lack of written description in the specification with regard to the structural and physical characteristics of the claimed isolated nucleic acid fragments and transgenic plants and seeds, and given the high level of unpredictability in this art of defining DNA fragments that would function as promoters, one skilled in the art would not have been in possession of the claimed isolated nucleic acid fragments and transgenic plants and seeds at the time this application was filed."

It was also indicated on page 3 of the Office Action that "another isolated nucleic acid having homology to SEQ ID NO:6 will function as a promoter cannot be assumed merely on the basis of sequence homology (Kim et al. and Benfey et al. as discussed in the previous Office Action)."

The Benfey et al. article concerns an analysis of the cauliflower mosaic virus (CaMv)35S promoter – combinatorial regulation of transcription in plants. The intact 35S